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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10 020,219	12.18.2001	Masayuki Ikeno	217555US0	5739

22850 7590 01.31.2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
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EXAMINER

ROBERTSON, JEFFREY

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 01/31/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Application No.

10/020,219

Applicant(s)

IKENO ET AL.

**Office Action Summary**

Examiner

Jeffrey B. Robertson

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication
- Failure to reply within the set or extended period for reply will by statute cause the application to become ABANDONED (35 U.S.C. § 133)
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b)

**Status**

- 1) Responsive to communication(s) filed on 18 December 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-10 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3 and 6-10 is/are rejected.
- 7) Claim(s) 4 and 5 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.

- 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 and 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujiki et al. (U.S. Patent No. 5,288,795).

This rejection covers situations where components (B) and (C) are the same.

For claim 1, in column 1, lines 5-12, Fujiki teaches an organopolysiloxane composition for molding purposes. In column 3, lines 4-29, Fujiki teaches a polymer that corresponds to applicant's organopolysiloxane (A), which has two vinyl groups per molecule and has a viscosity of 1000 to 100,000 centipoise at 25°C (1 to 100 Pa.s). For claims 2 and 3, in column 6, lines 55-58, In Example 1, Fujiki teaches a straight polymer that has a viscosity of 5 Pa.s. In column 7, lines 4-17, Fujiki teaches that a hydrogen polysiloxane is added corresponding to applicant's components (B) and (C), where the linear polymer is end-blocked with hydrogen atoms ( $R_2XSiO_{1/2}$ ) units and contains RHSiO units. There are no unsaturated groups in the polymer. For claim 5, this polymer falls within the second structural formula set forth in the claim. For claims 1 and 9, in column 5, lines 55-60, Fujiki teaches that a platinum catalyst is added, applicant's component (D). For claims 1 and 10, in column 5, lines 19-42, Fujiki discloses the addition of a silica filler in an amount of up to 50 parts by weight. For claims 1 and 7, in

column 4, lines 3-8, Fujiki teaches that 0.4 to 4 moles of silicon-bonded hydrogen are provided per alkenyl group of component (a).

For claims 1 and 8, since the two components (B) and (C) set forth by applicant may be the same, the teaching of the hydrogen polysiloxane by Fujiki as set forth above inherently encompasses the percentages of hydrogen set forth by applicant in these claims. "[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency' under 35 U.S.C. 102, on prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. In re Fitzgerald, 619 F. 2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

#### ***Allowable Subject Matter***

3. Claims 4 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

For claims 4 and 5, Fujiki et al. does not teach or suggest organopolysiloxanes of formula (I) as set forth by applicant for component (B). The hydrogen polysiloxane taught by Fujiki contains hydrogen atoms in the backbone of the polysiloxane, which is not allowed by applicant's formula (I).

***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lee et al. (U.S. Patent No. 4,032,502 is cited for teaching similar compositions to those set forth by applicant except that Lee et al. does not allow for component (C), which contains a RHSiO unit. Lee teaches away from polysiloxanes containing this unit. Brill, III (U.S. Patent No. 4,100,627), Kookootstedes et al. (U.S. Patent No. 4,701,017), Gutek (U.S. Patent No. 4,845,164), and Peccoux et al. (U.S. Patent No. 5,679,734) are cited for teaching similar compositions as claimed by applicant, except that these references do not claim the required Si-H/Si-vinyl ratios set forth by applicant. Kroupa (U.S. Patent No. 4,529,789), Kroupa (U.S. Patent No. 4,535,141), and Wilson (U.S. Patent No. 5,371,163) are cited for teaching similar compositions as set forth by applicant except that the amount of constituent (B) is present in greater than 70 mol% of the compositions.

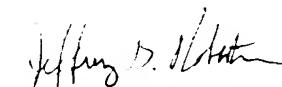
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (703) 306-5929. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jeffrey B. Robertson  
Examiner  
Art Unit 1712

JBR  
January 27, 2003